

Appl. No. 09/925,836
Response dated October 8, 2004
Atty. Docket No. 63854-5003

Remarks/Arguments

Applicants have neither amended nor canceled claims in this Response. Accordingly, claims 38 to 43, and 45 to 56 remain pending in this patent application. Applicants now address each and every point noted in above-identified Office action as follows:

I. Rejection of Claims

The Examiner has maintained his rejection of claims 43, 46 to 48, and 50 to 56 under 35 U.S.C. §103 as being allegedly unpatentable over Samonides in view of McNaul. The Examiner comments that Applicants' arguments presented in its response of April 16, 2004, were considered but not deemed persuasive. Applicants request reconsideration of this position in view of the points and discussion presented below.

A. Samonides

As noted in its earlier response, Applicants believe that the teaching in Samonides is very specific and clear with respect to the pressure-sensitive adhesive (PSA) substrates that it discloses. The object of the invention in Samonides is to form a PSA substrate that is capable of being printed upon subsequent to the placement of a PSA material onto the substrate. In an example embodiment, referring to FIG. 1, this is done sequentially in a continuous process.

A key requirement, however, to achieving this object is that the PSA material must be extruded onto the substrate surface in "as near a dry state as possible without heat." (see the Abstract). This is required "so that minimal drying is required prior to subsequent processing steps such as printing on the adhesive." (see the Abstract).

The Examiner admits that Samonides teaches drying of the PSA material prior to printing, but then alleges that such drying is not directed to the final state of the PSA. The Examiner then comments that "the adhesive is not in a final cured or fully developed state as the film is being

Appl. No. 09/925,836
Response dated October 8, 2004
Atty. Docket No. 63854-5003

formed.” Applicants assume that when the Examiner uses the term “film” in this context he is referring to the adhesive, as the Examiner has not before introduced this term in any other context.

Based on this understanding, and as presented in its earlier response, Applicants believe that the Examiner has confused the claim limitation at issue. Applicants’ independent claims 43 and 46 each specifically recite the method step of applying a film-forming material onto a surface of a PSA material. A key point of this method step is that such film-forming material is applied to the surface of the PSA material while the PSA material is in a non-final state. While the PSA of Applicants’ invention may arguably be applied to the substrate when the PSA is in a non-final state is not the same as the above-noted claim feature, requiring that the PSA be in a non-final state when the film-forming material is applied to it.

Further, contrary to the Examiner’s position that such drying of the PSA as taught by Samonides is not directed to the final state of the PSA, Samonides discloses in many passages throughout the written description the fact that the PSA material is water or solvent-based, and is dried to a final dried state of a finished PSA label. For example, Samonides discloses that the final moisture content for a PSA product is about 5 percent by weight, and that at the time of extrusion the PSA should be within 20 percentage points of this final moisture content (Column 3, lines 3 to 19). Samonides also discloses that subsequent to extrusion the applied PSA is dried by heat followed by cooling (Column 3, lines 41 to 45). Samonides further discloses that the PSA when extruded contains approximately 10 percent water at the time of extrusion and “is further dried to a water content of approximately 5 percent by weight, which is the normal water content for the finished pressure-sensitive acrylic label (Column 3, lines 50 to 56). Samonides provides still further disclosure regarding the need to dry the PSA material to the final state water content, indicating that “the water must be further reduced to about 5 percent by weight after extrusion (Column 3, lines 19 to 21). Other passages that disclose the important requirement of drying to the final product state of 5 percent water content can be found in Column lines 6 to 11, and lines 24 to 26.

Accordingly, based on these unambiguous teachings, it is logical to conclude that since the PSA disclosed in Samonides is a water or solvent based material, and since the final state

Appl. No. 09/925,836
Response dated October 8, 2004
Atty. Docket No. 63854-5003

of a PSA product formed from such PSA material has a final water content of 5 percent, then the process disclosed in Samonides of having to dry the PSA material to this 5 percent water content de facto produces a PSA material that is indeed in its final state, i.e., since the PSA material is dried to the final state water content of 5 percent then the PSA material must necessarily be in its final state.

Thus, Applicants submit that the Examiner's position alleging Samonides does not disclose processing the PSA into a finally cured or fully developed state is not disclosed or suggested in Samonides. In fact, in view of the clear and unambiguous requirement in Samonides that such final state PSA conditions be achieved prior to printing, Applicants contend that the Examiner's position is contrary to the teaching of Samonides. In view thereof, Samonides certainly provides no suggestion or motivation to produce a PSA substrate having a PSA material in non-final state prior to printing or subsequent treatment. Thus, one skilled in the art aware of Samonides would not find Applicants' methods as recited in independent claims 43 and 46 comprising this claim method feature to be obvious.

B. McNaul

As admitted by the Examiner, McNaul fails to disclose or remotely suggest the concept of using a non-final state PSA material in forming its printable laminate construction. Thus, like Samonides, one skilled in the art aware of McNaul would not find Applicants' methods as recited in independent claims 43 and 46 comprising this claim feature to be obvious.

C. Combination of Samonides and McNaul

Since Samonides and McNaul each independently fail to disclose or remotely suggest the subject claim feature for the reasons discussed above in detail, the combination of these two references cannot operate to motivate or suggest use of such claim feature missing in each to one skilled in the art. Accordingly, Applicants submit that the combination of Samonides and McNaul would not render its invention as recited in independent claims 43 and 46 obvious to one having ordinary skill in the art.

Appl. No. 09/925,836
Response dated October 8, 2004
Atty. Docket No. 63854-5003

In view thereof, Applicants respectfully request that the rejection of independent claims 43 and 46, and claims 47 to 48, and 50 to 56 depending respectively therefrom, under 35 U.S.C. §103 be reconsidered and withdrawn.

II. Allowed Claims

As noted in its earlier response, Applicants acknowledge with appreciation the noted allowance of claims 38 to 42, 45 and 49 and accept the same

III. Request for Telephone Interview with Examiner

Should, after carefully considering all of the points presented, the Examiner decide to maintain his rejections of the claims based on the two prior art patents discussed above, Applicants respectfully request that the Examiner please contact its attorney or record below for the purpose of conducting a telephone interview regarding any such maintained rejection. If possible, Applicants would like to invite the Examiner's supervisor to also participate in any such telephone interview.

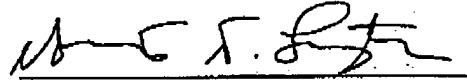
Appl. No. 09/925,836
Response dated October 8, 2004
Atty. Docket No. 63854-5003

IV. Conclusion

Applicants accept the allowance of claims 38 to 42, and claims 45 and 49, and respectfully request that the rejection of the remaining claims under 35 U.S.C. §103 be reconsidered and withdrawn, and that these remaining claims be passed to allowance.

The Commissioner is hereby authorized to charge any additional fees to Deposit Account No. 10-0440, or credit any overpayment to the same.

Respectfully submitted,



GRANT T. LANGTON
Reg. No. 39,739

Date: October 8, 2004

GTL/ke1
JEFFER, MANGELS, BUTLER & MARMARO LLP
Seventh Floor
1900 Avenue of the Stars
Los Angeles, CA 90067
Tel: (310) 203-8080
Fax: (310) 203-0567
Customer No. 24574